

REMARKS/ARGUMENTS

This Response is promptly filed to place the above-referenced case in condition for immediate allowance.

The status of the claims is as follows:

<u>Cancelled:</u>	None;
<u>Amended:</u>	None;
<u>Added:</u>	None; and
<u>Currently outstanding:</u>	1-48.

No new matter has been added to the application.

From the outstanding Office action of November 17, 2004 made final:

Claims 22-23 and 46-48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Day '015 patent; and Claims 1-20 and 24-45 stand rejected under 35 § U.S.C. § 103(a) as being unpatentable over the Day '015 patent in view of the Abecassis '340 patent.

Reconsideration is respectfully requested.

This response is filed in conjunction with a Request for Continued Examination (RCE). As such it addresses rejections, arguments, and comments made in both the Final Office action of November 17, 2004 and the Advisory action of March 14, 2005.

As set forth below, Applicant believes that the rejections based on § 102(e) and § 103(a) are misplaced and that it has not received a sufficient examination of its claims as provided by statute, rule, and regulation. The following citations are set forth for the Examiner's reference.

35 U.S.C. § 132(a) states:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention. (Emphasis added).

37 C.F.R. § 104(c)(2) states:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (Emphasis added).

MPEP § 2262 (page 2200-85, col. 1, ll. 4-7) states that, “The first Office action must be sufficiently detailed that the pertinency and manner of applying the cited prior art to the claims is clearly set forth therein.” (Emphasis added).

As Applicant set forth in the Reply to the First Office action sent July 15, 2004 (page 22):

The Examiner does not identify which elements of the Day ‘015 patent correspond to which claim limitations of Applicant. This has led to some significant confusion on the part of Applicant as it is unable to determine exactly which element being asserted by the Examiner as present in the Day ‘015 patent corresponds to which limitation in Applicant’s claims. This presents a very, very difficult question for Applicant as it is unsure as to how to address the Examiner’s rejection in a manner that is effective and efficient as it raises confusion, uncertainty, and doubt as to the basis of the rejection

The Examiner may consider such correspondence between elements in the cited patent and limitation in the pending claims to be clear upon mere general indication. Applicant here states for the record that the Examiner’s viewpoint is not clear to them [sic] as the lack of specificity (with respect to such element-limitation correspondence) creates significant (if not systemic) ambiguity.

[editor's note: indicating a specific example of lack of specificity] Applicant is assuming that the element of receiving feedback, etc, indicated by the Examiner is resident in the additional lines of text, col. 5, lines 19-22, as they are not otherwise indicated by the Examiner and as the large number of permutations of possible elements performing duplicate or multiple roles creates an impossible rejection to address as it is not known which elements are performing which functions for which events.

The Examiner did not respond to Applicant's written and verbal requests for more specificity and has not responded with rejections that are specific enough to comply with 37 C.F.R. § 104(c)(2) and MPEP § 2262.

Applicant respectfully requests that the Examiner set forth specifically those elements and relationships in the cited prior art (including Day and Abecassis) that form the basis for the Examiner's rejection. The passages cited by the Examiner are not sufficiently specific to indicate what specific items and/or relationships exist that provides the basis for the Examiner's rejections. Without such specificity, Applicant is wrongfully deprived of its right to claims of proper scope and protection for its new technology.

Applicant believes that the Examiner has not complied with the applicable law, rule, and regulation and that Applicant has repeatedly indicated the source of its confusion with respect to the Examiner's rejections. Despite this, Applicant has tried to address these rejections as best it could.

Applicant has repeatedly tried to engage the Examiner in colloquy and discussion in both written and verbal conversation with respect to the rejections and those elements in the inventions that serve as a basis of rejection for Applicant's claims. The Examiner's attention is particularly directed to 37 C.F.R. § 104(c)(2) where "the particular part relied on must be designated as nearly as practicable." Applicant provides a specific example of such lack of specificity in the remarks made below with respect to the § 103 rejections.

Applicant respectfully reminds the Examiner that all business to be transacted with the Patent Office is to be in writing under 37 C.F.R. § 1.2. It was to Applicant's dismay that the Examiner indicated that the Examiner had relied upon oral explanations of the "rating tool" with respect to the rejections of Claims 21-23 and 46-48. As Applicant understands it, all rejections must be made in writing and must be complete.

Furthermore, as set forth above, the passage cited by the Examiner in the Day '015 patent with regards to the purported "rating tool" is inapplicable to Applicant's claims for the reasons set forth above. The ability of the process in the Day '015 patent to determine data operating characteristics based on selection of data by a client as set forth in column 6, lines 9-25 of the Day '015 patent does not provide a "rating tool" for indicating a rating for a data stream currently played by a media player as set forth in Applicant's Claims 21 and 46.

The passage cited by the Examiner for the "rating tool" has nothing to do with a "user interface" as required by the preamble of Claims 21 and 46. For Claim 46, the Day patent does not disclose a "rating tool" enabling exclusion of a data stream.

Rejections must be complete per 37 C.F.R. § 104(a)(1). Per the Examiner's comments in the Advisory Action of 3/14/2005, the ratings tool was never previously mentioned in either

of the two prior Office actions. Consequently, these Office actions were incomplete as well as being insufficiently specific.

Consequently, Claims 21 and 46 and those claims that depend upon them (Claims 22 and 23 as well as Claims 47 and 48, respectively) are believed to be patentable over the Day patent. Applicant reserves the right to further set forth in more detail his rejections regarding the dependent claims indicated above as it is believed the assertions made in the Final Office action are not applicable to these dependent claims.

Rejections Under 35 U.S.C. § 102

The Examiner rejected Claims 21-23 and 46-48 under 35 U.S.C. § 102(e) as being anticipated by the Day '015 patent.

In rejecting Claims 21 and 46, the Examiner indicated that Day discloses a method, system and interface for broadcasting data streams through a computer network that includes the providing of a database of data streams, the selection of a data stream according to a selection method, the transmissions of one of these data streams, receiving feedback expressing a preference from the user, updating the selection method such the data streams transmitted to the user are biased according to the expressed preference.

Applicant does not agree with the Examiner's characterization of the Day '015 patent and further believes that the elements cited here against Claims 21 and 46 are misplaced. Claim 21 requires a media player, a rating tool, a data stream information display so that the user can indicate a preference regarding a data stream currently played by the media player. None of the elements cited by the Examiner indicate any of these claimed elements. The same

is similarly true for Claim 46 where the “rating tool” further enables exclusion of the data stream being rated.

Rejections Under 35 U.S.C. § 103

Claims 1–20 and 24–45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable under the combined teachings of the Day ‘015 patent in view of the Abecassis ‘340 patent. Applicant’s remarks with respect to the specificity of the Examiner’s rejections are incorporated herein as if fully set forth.

As an example of the specificity lacking in the Examiner’s rejections, Applicant directs the Examiner’s attention to the statement in paragraph 9 of the Final Office action that the Day ‘015 patent provides “a database of data streams available to said computer network, (col. 5, lines 24–38).”

Column 5, lines 24–38 read as follows:

... The server 207 receives the request and runs the VOD presentation formatter program. The VOD presentation formatter send the query to the application server portion 209 ...

... of the controller, which, in turn, queries the content management database. The results are returned to the VOD presentation formatter which dynamically builds an HTML page and returns the page containing the search results to the client. The preceding steps are repeated as necessary to narrow the search.

The client then selects an asset from the HTML page. The presentation formatter server 207 receives the request and runs the VSP (video selection presentation) formatter program. The VSP formatter passes the selection request to the controller 211 where an HTML metafile is created containing the pertinent information regarding the selected asset. The metafile is returned via the presentation formatter server to the client. The client's web browser 221 receives the HTML metafile, and, based upon the encoding type of the ...

... video, launches the video client code, which invokes a multimedia player, e.g., video viewer 223, on the client system to play back the asset. ...

The portions in italics are those sentence remnants that precede and proceed from the cited portion of the Day '015 patent.

In further explanation of this example, Applicant cannot tell what the Examiner is either referring to as the database or the data streams in that database. The "content management database" is indicated in col. 4, lines 2-7 as being an optional database containing additional information concerning available assets such as director, subject matter, actors, etc. for a particular video presentation. No mention is made of there being data streams present in the optional "content management database." As a result, Applicant is unaware of any other database in the cited passage, and the Examiner has apparently not pointed one out, that would suffice as prior art to Applicant's claims. The Examiner has not pointed out any database of data streams in the reference to the Day '015 patent.

Additionally, if the Examiner is referring to any data streams present in the cited portion of the Day '015 patent, Applicant cannot tell if the data streams are the results returned to the VOD, the dynamically built HTML page, the request received by the presentation formatter server, the HTML file created by the controller or the preceding selection request passed by the VSP formatter, or the HTML metafile received by the client's web browser. The Examiner has not specifically identified what data stream acts as prior art to those data streams in Applicant's claims, including the claims rejected under 35 U.S.C. § 103, Claims 1-20 and 24-45.

This example above is but one of many that Applicant could cite for the other elements in the Day '015 patent indicated by the Examiner, including "selecting a data stream," "transmitting one of said data streams," and the others listed in paragraph 9 of the Examiner's Final action of November 17, 2004. Applicant reserves the right to go into further detail regarding these or other individual elements cited by the Examiner as anticipating or making obvious elements in Applicant's claims. Applicant refrains from doing so here in order to avoid being prolix.

As can be seen above, when taken as a prima facie rejection of Applicant's claims, the Examiner has not indicated subject matter that would act as prior art to Applicant's claims. Consequently, Applicant's claims should be allowed as there are no disabling prior art references under either 35 U.S.C. § 102 or § 103 that anticipate or make obvious Applicant's claims.

Applicant believes it is not its burden to prove the merits of its technology. Instead, the burden of proof always rests with the Examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.... If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.").

Lastly, Applicant believes that the Examiner is in error with respect to an applicant not being able to argue references individually to overcome an obviousness rejection. If the combination of references does not make obvious an applicant's claims, one reason may be that

a first reference relied on by an Examiner is inadequate for those purposes. When an applicant points out the inadequacy of the reference, the obviousness rejection then fails as the other reference may not supply or remedy the shortcoming in the first reference. Obviousness-type rejections always fail when either or both: the cited references in combination do not have the elements recited in an applicant's claims and there is no motivation, teaching, etc. to combine such references that predates the applicant's application.

Due to the foregoing, Applicant believes that no proper rejection of Applicant's claims has occurred. At the outset, no prima facie case has been made for unpatentability and no such case has been with sufficient specificity to inform Applicant as to what elements and relationships in the prior art serve to reject Applicant's claims. Furthermore, when these rejections are taken at face value, as they must be, no disabling prior art has been indicated by the Examiner.

Consequently, Applicant believes that all the claims are allowable over the cited prior art and that the claims should be allowed at an early date.

In view of the above, the Examiner is respectfully requested to reconsider her position in view of the remarks made herein and the structural distinctions now set forth. The Examiner's rejection of the outstanding claims is believed to no longer apply. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner

- disagrees with any of such opinions, it is respectfully requested that the Examiner specifically
- indicate those portions of the respective references providing the basis for a contrary view.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicants invites the Examiner to contact Applicant's representative at the number listed below.

With the above-referenced changes, it is believed that the application is in a condition for allowance; and Applicants respectfully requests the Examiner to pass the application on to

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allowance. It is not believed that any additional fees are due; however, in the event any additional fees are due, the Examiner is authorized to charge Applicant's Attorney's Deposit Account No. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP

Date: May 16, 2005


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Enclosures

Petition for Extension of Time - 3 Months
Acknowledgement Postcard

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May 16, 2005
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Andrew S. Jordan, Reg. No. 33,917
Date *5/16/05*